Case 8622

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In the Application of **THOMAS J. KLOFTA, ET AL.**	: :	
Serial No.: 09/898,880	:	Group Art Unit: 1616
Filed: July 3, 2001	:	Examiner: K. M. George
For: FILM-FORMING COMPOSITIONS FOR PROTECTING SKIN FROM BODY FLUIDS AND ARTICLES MADE THEREFROM	:	

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a Brief on Appeal of currently pending Claims 1-25 of the above-identified application of which Claims 1-19 have been withdrawn. Claims 20-25 were finally rejected in an Office Action dated August 6, 2003. A Notice of Appeal was transmitted on November 19, 2003. According to 37 C.F.R. § 1.192, this Brief is being filed in triplicate within two months of the Office date of receipt of the Notice of Appeal (November 19, 2003). As January 19, 2004, is a Federal holiday within the District of Columbia, this Brief is believed to be timely filed, per 35 U.S.C. § 21, on January 20, 2004. Authorization is given to charge any fees required under 37 CFR § 1.17 related to this appeal to Deposit Account No. 16-2480.

REAL PARTY IN INTEREST

The Appellants who are named in the caption of the brief have assigned this application to the Procter & Gamble Company.

The Office Fails to Provide an Enabling Disclosure from the References Cited

Case law states that the "[r]eferences relied upon to support a rejection under 35 U.S.C. 103 must provide an enabling disclosure, i.e., they must place the claimed invention in the possession of the public." *In re Payne*, 606 F.2d 303, 314 (CCPA 1979). Roe and Wenninger merely teach the use, without specificity or quantification, of optional ingredients in the lotion composition and article disclosed in Roe. The possible resultant combinations of each optional ingredient both alone and in combination with the other optional ingredients are numerous. Since no teaching exists within the reference, the appropriate amount of any selected optional ingredient must be determined experimentally by one skilled in the art. The Office has asserted that "determination of particular concentrations is within the skill of the ordinary worker as part of the process of normal optimization." *See* Office Action dated March 19, 2003, page 3. However, given the number of optional ingredients available, the number of possible species available for each optional ingredient, and the experimentation necessary to determine the appropriate amount of each species; the teachings of Roe and Wenninger are at best an invitation to try various combinations of the optional ingredients at variable amounts. Case law clearly states that "obvious to try" is not the standard for obviousness. *See In re Geiger*, 815 F.2d 686, 687 (Fed. Cir. 1987). As such, the Office has failed to establish a *prima facie* case of obvious.

SUMMARY

The Appellants submit that they have shown that the Examiner's final rejection of Claims 20-25 was improper and that the claims are unobvious over the cited art. Accordingly, the Appellants respectfully request that the Board of Patent Appeals and Interferences reverse the Examiner's final rejection under 35 USC § 103(a) and remand with directions to allow all of the pending claims of the present application.

Respectfully submitted,

For: Thomas J. Klofta et al.

By Eric T. Addington

Eric T. Addington
Agent for Appellant(s)
Registration No. 52,403
(513) 626-1602

Date: January 20, 2004
Customer No. 27752